

Remarks

Prior to this communication, claims 3 – 7, 10, 11, and 19 – 25 are pending. Claims 3 – 7, 10, 11, and 19 – 25 were rejected. By this amendment, claims 19, 22, and 24 have been amended. Examination and reconsideration of the claims in view of the following remarks are respectfully requested.

35 U.S.C. §103 Rejections

Claims 3 – 7, 10, 11, and 19 – 25 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over by Canadian Patent No. 2 334 546 (“Jackson”).

As indicated on page 2 of the Action, Jackson “fails to teach incrementing only the eligible jackpot prize.”

However, the Examiner then indicated that because “Jackson teaches incrementing the wager associated jackpot,” “to choose to increment the other (i.e. unqualified) jackpots or not is a matter of design choice well within the skill set of an ordinary artisan.” (Pages 2 – 3, Action.)

Applicant respectfully disagrees.

Applicant disputes the Examiner’s assertions that “increment only the eligible jackpot prize [based on the selected wager]” is simply a “design choice [that is] well within the skill set of an ordinary artisan.” (Page 3, Action.) Because Jackson clearly does not disclose or suggest “[incrementing] **only** eligible jackpot prize based on the selected wager,” as indicated in the Action, Applicant can only assume that the Examiner is taking Official Notice of the subject matter disclosed in claim 19 regarding “increment only eligible jackpot prize [based on the selected wager].”

Assuming the Examiner is asserting Official Notice that the subject of the above listed statements is “design choice,” Applicant respectfully traverses the perceived and explicit assertions as further set forth below. Alternatively, if the Examiner’s assertions are based on the personal

knowledge of the Examiner, then under MPEP § 2144.03 (C) and 37 C.F.R. § 1.104 (d) (2), the assertions must be supported by an affidavit from the Examiner.

According to MPEP § 2144.03 (A), Official Notice, without supporting references, should **only** be asserted when the subjects asserted to be common knowledge are “capable of instant and unquestionable demonstration as being well-known.” That is, the subjects asserted must be of “notorious character” under MPEP § 2144.03 (A). However, Applicant respectfully submits that the subject matter of the perceived and explicit assertions of Official Notice, as stated in pages 2 and 3 of the Action, are not “design choice” as evidenced by the searched and cited prior art. Applicant respectfully submits that the Examiner has performed “a thorough search of the prior art,” as part of the Examiner’s obligation in examining the application under MPEP § 904.02.

Additionally, Applicant respectfully submits that the Examiner’s searched and cited references found during the Examiner’s thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner’s thorough and detailed search of the relevant prior art, none of the prior art taught or suggested the subject matter of the perceived and explicit assertions of Official Notice with regards to claim 19, as stated in pages 2 and 3 of the Action. That is, the Examiner’s thorough and detailed search of the prior art has failed to yield any mention of the limitations in claims 19, which the Examiner has conceded are not explicitly found in Jackson, and which the Examiner asserts are widely known in the art. Applicant respectfully submits that if the subject matter of these assertions of Official Notice had been of “notorious character” and “capable of instant and unquestionable demonstration as being well-known” under MPEP § 2144.03 (A), then the subject matter would have appeared to the Examiner during the Examiner’s thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, Applicant respectfully submits that the prior art does not teach the subject matter of the perceived assertions of Official Notice stated in pages 2 and 3 of the Action and respectfully traverses the perceived assertions of Official Notice.

Applicant specifically challenges the perceived and explicit assertions of Official Notice with regard to claim 19. As stated above, Applicant respectfully traverses the perceived and explicit

assertions of Official Notice and submits that the subject matter of claim 19 is not of such “notorious character” that it is “capable of instant and unquestionable demonstration as being well-known.” Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support of the perceived assertions of Official Notice if the Examiner intends to maintain any rejection based thereon. Additionally, Applicant respectfully requests the Examiner reconsider the assertion of Official Notice and provide any basis for the assertions of Official Notice.

Nonetheless, Applicant has amended claim 19 to advance the prosecution of the application. Particularly, Applicant has amended claim 19 to include “a gaming control system” that can “increment only the eligible jackpot prize based on the selected wager.”

Jackson does not teach or suggest a gaming control system” that can “increment only the eligible jackpot prize based on the selected wager.”

Rather, Jackson discloses that all the jackpots are incremented regardless of the wager. Specifically, Jackson discloses that “after the player deposits the desired monetary amount ... the various jackpots are incremented.” (Page 5, lines 6 – 8.)

Thus, Jackson does not teach or suggest all elements of claim 19, nor would it have been obvious in view of Jackson to increment only one jackpot prize, as discussed above. To cause such a change in Jackson, while lacking motive to do so, would result in a completely different operation of Jackson’s gaming machine.

Accordingly, claim 19 and dependent claims 3 – 7, 10, 11, 20, and 21 are allowable.

Amended claim 22 is directed to a “gaming machine” that includes, among other things, “a plurality of jackpot prizes ... wherein only one selection ... is contributed to in response to the staking.”

Therefore, claim 22 and dependent claim 23 are allowable for at least the same reasons set forth above with respect to claim 19.

Similarly, amended claim 24 is directed to a “gaming system” that includes, among other things, “wherein only one selection ... of the jackpots is contributed to in response to the staking of a wager.”

Therefore, claim 24 and dependent claim 25 are allowable for at least the same reasons set forth above with respect to claim 19.

No new matter has been added.

Conclusion

Applicant respectfully submits that all of claims 3 – 7, 10, 11, and 19 – 25 are allowable. In the event that the Examiner believes a telephone interview with the undersigned Applicant's Representative would be helpful in advancing prosecution of this patent application, the undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

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/Lawrence M. Jarvis/
Lawrence M. Jarvis
Reg. No. 27,341

McAndrews, Held & Malloy, Ltd.
500 W. Madison Street
34th Floor
Chicago, IL 60661
Phone (312) 775-8000
Fax (312) 775-8100